

REMARKS

In the outstanding Office Action, the Examiner has withdrawn the final rejection in light of the appeal brief filed on behalf of applicants. As a result, the Examiner has withdrawn the allowance of claim 35 in this application and has interposed a rejection of all of the pending claims, namely claims 35-38. In an effort to reduce the issues in this application, applicants have cancelled claim 37 without prejudice, leaving claims 35, 36 and 38 pending in this application.

In the outstanding Office Action, the Examiner has interposed rejections of claims 35 and 38 based on the first paragraph of § 112, the Examiner contending that the description of the present application fails to support those two claims. The real issue raised by the Examiner is whether claim 35, in calling for a "non-conducting porous separator", is supported by the present specification. Applicants had previously pointed out and the Examiner had accepted the proposition, that the series of openings in element 375 provided support for the recitation of a "non-conducting porous separator". Now, the Examiner comes back in a further Office Action with the argument that a pore is different from a hole, and, based on that distinction, concludes that the holes in element 375 of Fig. 8 in the present application do not amount to pores.

First of all, it is black letter law that claims should be given their broadest reasonable interpretation during prosecution. So the Court held in In re Bigio (Fed. Cir., 2004), 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1210-11. Similarly, in In re American Academy Of Science Tech Center (Fed. Cir., 2004), 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830, the Court wrote:

"During examination, claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art."

Even though there may be structural differences between a "pore" and a "hole", those differences are, in fact, differences in degree. In the usual course of things, a hole has a larger dimension than a pore but both serve to guide and control the flow of a fluid.

That is illustrated by the specification of the present application as well as the specification of Jorne U.S. Patent No. 6,132,587 from which claim 35 has been copied. Both the "pores" and the "holes" function in the same way to control the flow of fluid through the distributor to promote uniform distribution of liquid over the surface of the wafer.

One skilled in the art would be very much aware that such structures, even to the extent that they are different in terms of magnitude, function in the same way and hence can be used interchangeably. The Examiner, in interpreting § 112, ¶ 1, so narrowly overlooks recent developments in the law dealing with the application of § 112, ¶ 1 in interference situations. Applicants refer, of course, to Bilstad v. Wakalopoulos (Fed. Cir., 2004), 386 F.3d 1116, 1125, 72 USPQ2d 1785, 1791-92 where the Court observed that the controlling standard is what one skilled in the art would reasonably understand from the disclosure of the present application. In this case, one skilled in the art would surely appreciate how the

pores and holes used to distribute fluid evenly and uniformly across a wafer are essentially the same even though the holes may have larger dimensions than the pores.

Whether or not the structures of the specific embodiments in the Jorne patent are precisely the same as the structures in the specific embodiments set forth in the present application is not a relevant question. Quite the contrary, the relevant issue is whether the present application fairly supports the phrase "a non-conducting porous separator". The Examiner has already agreed, and apparently does not now dispute, that the element described in the present specification is not a conductor and therefore that aspect of the disputed phrase is supported. Apparently the Examiner's contention is that the element in the present application is not "porous" -- even though it admittedly contains a series of openings. Since the claim imposes no limitation on the size of the openings, the present specification plainly supports both "holes" and "pores".

The Examiner has also raised a question in connection with claim 38 and the portion of the claim calling for "a distributor positioned in said reservoir including a disk having a plurality of holes adapted to provide a flow of electrolyte through the disk that is uniform along a radius of the disk". As the Examiner observes, the present specification describes the function of the diffusion plate 375 illustrated in Fig. 8 of the drawing as providing a more even distribution of the fluid plating bath "across the wafer W". In citing to the specification to support his argument that applicants do not describe uniformity "along a radius" of the wafer, the Examiner has failed to take into account the very next sentence of the present specification. That calls for fluid passages which are provided "over all or a

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a portion" of the diffusion plate. As is plain to see from the drawing, providing passages over all of the diffusion plate means that the openings extend over a diameter of the wafer -- two radii. One skilled in the art would thus find a recitation of uniformity "along a radius" supported by the present specification.

Therefore, the Examiner is respectfully requested to reconsider the rejection based on § 112, ¶ 1.

Respecting claim 36, that claim was, as the Examiner is aware, copied from claim 2 of the Jorne patent. Applicants plan to submit a request for re-examination of the Jorne patent, specifically including claim 2. Should the Examiner determine that claim 2 of the Jorne patent is anticipated by the Mori prior art reference, then applicants will cancel claim 36 from the present application.

As a result of the above amendments, claims 35, 36 and 38 remain pending. No claims have been amended. No new matter has been added.

Respectfully submitted,

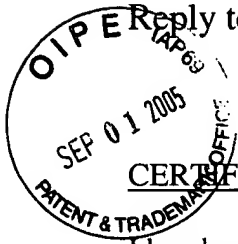


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